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TECHNOLOGY CENTER 2100

In re Application of: YAMAGAMI, KENJI
Application No. 10/759,581
Filed: 16 January 2004
For: METHOD AND APPARATUS FOR
LIMITING ACCESS TO A STORAGE SYSTEM

DECISION ON PETITION
TO MAKE SPECIAL
(ACCELERATED EXAMINATION)
UNDER M.P.E.P. §708.02 (VIII)

This is a decision on the petition filed 01 August 2005, to make special the captioned application under 37 C.F.R. 102(d) and M.P.E.P. § 708.02(VIII): Accelerated Examination.

The Petition is **DISMISSED**.

M.P.E.P. § 708.02, Section VIII which sets out the prerequisites for a grantable petition for Accelerated Examination under 37 C.F.R. § 102(d) states in relevant part:

A new application (one which has not received any examination by the examiner) may be granted special status provided that applicant (and this term includes applicant's attorney or agent) complies with each of the following items:

- (a) Submits a petition to make special accompanied by the fee set forth in 37 CFR 1.17(h);
- (b) Presents all claims directed to a single invention, or if the Office determines that all the claims presented are not obviously directed to a single invention, will make an election without traverse as a prerequisite to the grant of special status;
- (c) Submits a statement(s) that a pre-examination search was made, listing the field of search by class and subclass, publication, Chemical Abstracts, foreign patents, etc. The pre-examination search must be directed to the invention as claimed in the application for which special status is requested. A search made by a foreign patent office satisfies this requirement;
- (d) Submits one copy each of the references deemed most closely related to the subject matter encompassed by the claims if said references are not already of record; and
- (e) Submits a detailed discussion of the references, which discussion points out, with the particularity required by 37 CFR 1.111 (b) and (c), how the claimed subject matter is patentable over the references.

In this case, the petition fails to properly discuss the claimed subject matter in accordance with the section (e) requirements.

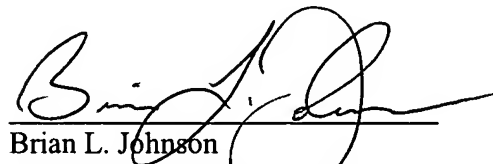
In the petition filed 01 August 2005, in section (e) under the heading "Claimed Subject Matter of the Present Invention", the first sentence states that "[t]here are nine independent claims among the 50 claims that are pending in the instant application." The USPTO records, however, show the Application has four independent claims and 33 claims in toto. Consequently, the petition's specifying that nine independent claims and fifty claims are in the case creates confusion and a question regarding the actual claims at issue.

In addition and contrary to Petitioner's remarks regarding claim language that defines over the references provided, the phrase "and not permitted otherwise" is not found in independent claim 1 of the instant application. The petition must address **each of the independent claims in the Application** with respect to the prior art in order to satisfy section (e) supra. Petitioner is therefore required to properly **identify each of the independent claims in the case** and submit a detailed discussion which points out how **each independent-claim of the invention** distinguishes over the relevant teachings of each reference.

Petition to Make Special **DISMISSED**.

Petitioner is given one opportunity to perfect the petition. Any request for reconsideration must be filed within TWO MONTHS of the mail date of this decision.

Until the renewed petition is submitted, the application will be returned to the examiner's docket to await treatment on the merits in the normal order of examination.



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